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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/661,159	09/12/2003	Jaime Salvador Vargas	ENDOV-001/US	6784

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PATENT DEPT - INTUITIVE SURGICAL OPERATIONS
1266 KIFER RD BLDG 101
SUNNYVALE, CA 94086

EXAMINER

HOEKSTRA, JEFFREY GERBEN

ART UNIT	PAPER NUMBER
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3736

MAIL DATE	DELIVERY MODE
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02/10/2011

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/661,159	VARGAS, JAIME SALVADOR	
	Examiner	Art Unit	
	Jeffrey G. Hoekstra	3736	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 26-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 December 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/20/2010 has been entered.

Notice of Amendment

2. In response to the amendment(s) filed on 12/20/2010, amended claim(s) 26 and cancelled claim(s) 18-25 and 31-55 is/are acknowledged. The current objections and/or rejections is/are *withdrawn*. The following new and/or reiterated ground(s) of rejection is/are set forth:

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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4. Claims 26-30 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Intoccia (US 2003/0229332 A1) as broadly as claimed.

5. For claim 26, Intoccia discloses a rigidizing mechanism (as best seen in Figures 3-5) (paragraphs 31-36, 50, and 51), comprising *inter alia*:

- an inner element (32) (as best seen in Figures 3-5) (paragraphs 31-36, 50, and 51) and an outer element (15) (as best seen in Figures 3-5) (paragraphs 31-36, 50, and 51) positioned concentrically around the inner element (as best seen in Figures 3-5) (paragraphs 31-36, 50, and 51), wherein the inner and outer elements are flexible (as best seen in Figures 3-5) (paragraphs 31-36, 50, and 51); and
- a plurality of components (31, 38, and 36) (as best seen in Figures 3-5) (paragraphs 31-36, 50, and 51) positioned between the inner and outer elements (as best seen in Figures 3-5) (paragraphs 31-36, 50, and 51), each component being distinct from the inner and outer elements (as best seen in Figures 3-5) (paragraphs 31-36, 50, and 51);
- wherein in a first state the components interfere between the inner and outer elements with a force sufficient to prevent the inner and outer elements from sliding longitudinally relative to one another (as best seen in Figures 3-5) (paragraphs 31-36, 50, and 51), and in a second state the components do not significantly interfere with the inner and outer elements sliding longitudinally relative to one another (as best seen in Figures 3-5) (paragraphs 31-36, 50, and 51).

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6. For claim 27, Intoccia discloses a mechanism, wherein the plurality of components comprises an electroactive polymer (the printed electroactive polymer on catheter 36) (as best seen in Figures 3-5) (paragraph 51 and claim 26).

7. For claim 28, Intoccia discloses a mechanism, wherein the plurality of components comprise balloons (31 and 38) (as best seen in Figures 3-5) (paragraphs 31-36, 50, and 51).

8. For claim 29, Intoccia discloses a mechanism, wherein the plurality of components are energized and expanded radially in the first state (as best seen in Figures 3-5) (paragraphs 31-36, 50, and 51).

9. For claim 30, Intoccia discloses a mechanism, wherein the plurality of components are energized and contracted radially in the second state (as best seen in Figures 3-5) (paragraphs 31-36, 50, and 51).

Response to Arguments

10. Applicant's arguments with respect to claims 26-30 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey G. Hoekstra whose telephone number is (571)272-7232. The examiner can normally be reached on Monday through Friday 8am to 5pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571)272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeffrey G. Hoekstra/
Primary Examiner, Art Unit 3736